

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2137574 BY
SOLDAN HOLDING & BONBONSPEZIALITATEN GMBH
TO REGISTER A TRADE MARK IN CLASSES 5 & 30**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 48318
BY FERRERO S.P.A & SOREMARTEC S.A.**

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No 48318 by Ferrero S.p.A. & Soremartec S.A.**

BACKGROUND

1. On 1 July 1997, Soldan Holding & Bonbonspezialitäten GmbH of Nurnberg, Germany, applied to register the trade mark shown below in Classes 5 & 30:



2. The application was examined and was subsequently published for the following range of goods:

Class 5

“Pharmaceutical and sanitary substances and preparations; chemical preparations and substances for medical, pharmaceutical and sanitary purposes; preparations and substances for treatment of respiratory disease, infection, ailments and complaints; nose sprays; nose drops; oral medicated sprays; medicated candy, lozenges and pastilles; cough syrups, lozenges, drops, sprays, balsams and liniments; food for babies; medicated teas”.

Class 30

“Sugar; dextrose; dextrose tablets; compressure sugar tablets; confectionery; chewing gum; sugar gums; lozenges; eucalyptus lozenges; ices; dietetic confectionery; dietetic toffees; dietetic bakery products and preparations made from cereals; dietetic chocolate; dietetic chewing gum; dragees, bars, chewing gums, sugar gums and bakery products; vitamin confectionery and candy; preparations and products made from flour and cereals; bread, pastry; cakes; buns, bakery products”.

3. The application is opposed by Ferrero S.p.A of Cuneo, Italy and Soremartec S.A. of Schoppach-Arlon, Belgium. In their Statement of Grounds the opponents say that they have made substantial use of the trade mark KINDER and have acquired a considerable reputation in the goods sold under the trade mark. They identify fifty one registered trade marks owned by the respective opponents in the United Kingdom in which the word KINDER appears either alone or together with others elements - details of these registrations can be found in Annex A to this decision. The opponents base their objections on the following sections of the Act:

- Section 3(1)(b) because the applicants’ trade mark is devoid of distinctive character;
- Section 3(3)(b) because the applicants’ trade mark is of such a nature as to deceive the public;
- Section 3(4) because use of the applicants’ trade mark is prohibited in the United Kingdom by a rule of law or by provisions of Community law;
- Section 3(6) because the applicants’ trade mark was applied for in bad faith;
- Section 5(2)(b) because the applicants’ trade mark is similar to earlier trade marks owned by the opponents and is to be registered for goods the same as and/or similar to those for which the earlier trade marks are protected;
- Section 5(3) that in so far as any of the opponents’ earlier trade marks are found to be protected for goods which are neither identical or similar to those for which the applicants’ mark is to be registered, the opponents submit that their earlier trade marks have a reputation in the United Kingdom and that the use of the applicants’ mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade marks;
- Section 5(4)(a) because use of the applicants’ trade mark is liable to be prevented by virtue of a rule of law (in particular, the law of passing off and/or the provisions of Section 56 of the Act).

4. The applicants filed a Counter-Statement which, in essence, consists of a denial of the various grounds of opposition.

5. Both sides filed evidence and both seek an award of costs. The matter came to be heard on 30 May 2002. At the Hearing the applicants were represented by Mr Richard Arnold of Her Majesty's Counsel instructed by Boulton Wade Tennant, Trade Marks Attorneys and Carpmaels & Ransford, Trade Mark Attorneys; the opponents were represented by Mr Michael Edenborough of Counsel instructed by Taylor Joynson Garrett, Solicitors.

Opponents evidence-in-chief

6. This consists of seven declarations. The first declaration dated 14 August 1998 is by Vivienne Wooll. Ms Wooll states that she is the Manager External Affairs of Ferrero UK Limited, a member company of Ferrero Group (the Group) of which Ferrero SpA of Cuneo, Italy and Soremartec S.A. of Schoppach-Arlon, Belgium are also members (the Companies). Ms Wooll has held her current position since 1985; she confirms that she is authorised to make her declaration on behalf of the companies and that the information in her declaration comes from either her own knowledge or from the records of the companies to which she has full access. The following points emerge from Ms Wooll's declaration:

- that Ferrero UK Limited is the sole importer of Ferrero products in the United Kingdom;
- that the KINDER trade mark was first used by the Group in the United Kingdom in 1967 and that the Group have sold the following KINDER products in the United Kingdom: KINDER MILK SLICE, KINDER SURPRISE, KINDER CHOCOLATE, KINDER MAXI, KINDER BUENO and KINDER JOY. These are collectively referred to as the products. Photocopies of the packaging of the products (except KINDER MAXI sold by the Group under the KINDER trade mark are provided in exhibit VW1;
- that products have been sold by the Group under the KINDER trade mark in the United Kingdom and that products have been available in branches of at least the following retail outlets: Sainsburys, Tesco, Safeway, Gateway, Kwik Save and the Co-Op. Exhibit VW2 consists of sample invoices of products sold under the KINDER trade mark;
- exhibit VW3 consists of a table showing sales in tonnes, consumer units and net revenue of products in the United Kingdom since 1967. I note that the net revenue under the respective trade marks in the periods indicated is as follows: KINDER MILK SLICE (1986/87-1994/95) - £3.2m; KINDER SURPRISE (eggs) (1980/81 - 1994/95) - £91.3m; KINDER CHOCOLATE (packs) (1986/87-1994/95)- £2.7m; KINDER MAXI (1990/91-1993/94) - £313K and KINDER BUENO (1990/91-1994/95) - £ 2.8m. Figures are also provided for invoices sales in the United Kingdom of goods under the KINDER JOY trade mark in the period September 1995 to July 1998 but these relate to sales after the material date in these proceedings;
- approximate annual amounts spent on advertising the various trade marks is provided as is said to be as follows: KINDER SURPRISE - between 1983 and 1994/1995 approximately £12m; KINDER BUENO - between 1992 and 1994/95 approximately

£197k; KINDER CHOCOLATE - between 1987 and 1994/95 approximately £300k and KINDER MILK SLICE - between 1989 and 1994/95 approximately £900k. Exhibits VW4 and VW5 consist respectively of: copies of advertising material for certain of the products together with catalogues and other literature produced by the Group and a video containing television advertisements for the trade marks KINDER MILK SLICE (1989-1990), KINDER SURPRISE (shown since 1995) and KINDER BUENO (shown in 1994 and 1995).

7. The second statutory declaration dated 18 February 1999 is by James Setchell. Mr Setchell is a Trainee Trade Mark Attorney at Haseltine Lake Trademarks. Exhibit JCS1 to his declaration consists of copies of the registrations identified by the opponents in their Statement of Grounds, such copies having been obtained from the Trade Marks Registry's database on 5 February 1999.

8. The third declaration dated 18 February 1999 is by Michael Robert Morris. Mr Morris states that he is a Corporate Investigator employed by Keypoint Services Limited of Hampton, Middlesex a position he has held since 1994. He explains that in July 1998 acting under instructions from Taylor Joynson Garrett he carried out enquiries to determine if trade mark Nos 1240460 KINDERGEN and 1358486 KINDER-VITES were being used in the United Kingdom. I do not think it is necessary to summarise the remainder of Mr Morris's declaration or exhibits MRM1 and MRM2 thereto here, but note his investigations which suggest that (i) the product sold under the KINDERGEN mark is a tube or sip feed designed to provide complete nutritional support or supplementary feeding for infants and children with chronic renal failure and that it is only available on prescription and (ii) that the KINDER-VITE product which is a chewable children's vitamin is not available in the United Kingdom and is only available in Russia under a Russian label.

9. The remaining declarations are from employees of the firm of Taylor Joynson Garrett who are the opponents' solicitors in these proceedings. They are as follows:

Christopher James Benson (solicitor) dated 3 March 1999 and exhibits CJB1-CJB3 thereto;

Wolfgang Kotzur (trainee solicitor) dated 1 March 1999 and exhibits WK1-WK3 thereto;

Christopher David Miller (solicitor) dated 19 February 1999 and exhibits CDM1-CDM3 thereto;

Michelle Sylvia Rodrigues (solicitor) dated 23 February 1999 and exhibits MSR1-MSR3 thereto.

10. The content of the declarations of Mr Benson and Mr Kotzur are reproduced verbatim below:

Mr Benson

"1. I am a solicitor in the firm of Taylor Joynson Garrett, solicitors for Ferrero SpA and Soremartec (the opponents) in this matter. Save where otherwise appears, the

facts of the matters to which I depose are within my personal knowledge through my involvement in this matter. Insofar as I rely on information communicated to me by third parties, I believe this information to be true.

2. On 3 September 1998, I travelled with colleagues to Dartford in Kent in order to conduct surveys involving members of the public.
3. There is now produced and shown to me marked CJB 1 a copy of the questionnaire used for the survey which I and my colleague Christopher David Miller carried out.
4. The survey took place at the Royal Victoria and Bull public house in Dartford. Members of the public were approached on the street outside by representatives of Field Management Limited and recruited for a face to face interview.
5. I interviewed members of the public brought to me by agents of Field Management and recorded their responses on a questionnaire.
6. There is now shown to me and marked CJB2 copies of the photocopies referred to at question one. I showed the interviewee the KINDER SURPRISE egg when asking question eight.
7. I confirm that the interviewees were not at any stage led or encouraged to give answers that would assist the opponents or which were detrimental to the case of Soldan Holding & Bonbonspezialitäten GmbH. All the interviews I carried out during the survey I conducted openly and honestly and interviewees responses were recorded in their entirety.
8. I interviewed and completed questionnaires for 29 people in total. There is now produced and shown to me marked CJB3 copies of all the original completed questionnaires showing the results of all the interviews which were conducted by me in respect of this survey in Dartford.
9. I have read Christopher David Miller's affidavit and the replies of the 16 members of the public he questioned.
10. The following result emerges from the survey:-

In response to question 12, 28 out of the 45 people questioned (62.22%) said they would be surprised that there was no connection between KINDER EUKAL, KINDER EM EUKAL and KINDER FÜR KINDER (sic) on the one hand and "the people who make KINDER SURPRISE" on the other.
11. I have read the declarations of Michelle Sylvia Rodrigues and Wolfgang Kotzur and the replies of the 40 members of the public they questioned.
12. The following results emerge from the survey:-

12.1 In response to question 1, what does the word KINDER mean to you, 27 people out of the 40 questioned (67.5%) said only either chocolate, egg, chocolate egg or Kinder egg. 1 person said both children and Kinder egg.

12.2 Of the six people who only said child or children in response to question one, four of them said chocolate egg when asked what the word KINDER means to them in respect of food in response to question 2."

Mr Kotzur

"1. I am trainee solicitor in the firm of Taylor Joynson Garrett, solicitors for Ferrero SpA and Soremartec (the opponents) in this matter. Save where otherwise appears, the facts of the matters to which I depose are within my personal knowledge through my involvement in this matter. Insofar as I rely on information communicated to me by third parties, I believe this information to be true.

2. On 3 September 1998, I travelled with colleagues to Dartford in Kent in order to conduct surveys involving members of the public.

3. There is now produced and shown to me marked WK1 a copy of the questionnaire used for the survey which I and my colleague Michelle Sylvia Rodrigues carried out.

4. The survey took place at the Royal Victoria and Bull public house in Dartford. Members of the public were approached on the street outside by representatives of Field Management Limited and recruited for a face to face interview.

5. I interviewed members of the public brought to me by agents of Field Management and recorded their responses on a questionnaire.

6. There is now shown to me and marked WK2 the KINDER word card referred to at question one. I showed the interviewee the KINDER SURPRISE egg when asking question four, the packaging of the KINDER CHOCOLATE product asking question nine, the packaging of the KINDER BUENO product when asking question fourteen and the KINDER JOY product when asking question nineteen.

7. I confirm that the interviewees were not at any stage led or encouraged to give answers that would assist the opponents or which were detrimental to the case of Soldan Holding & Bonbonspezialitäten GmbH. All the interviews I carried out during the survey I conducted openly and honestly and interviewees responses were recorded in their entirety.

8. I interviewed and completed questionnaires for two people in total. There is now produced and shown to me marked WK3 copies of all the original completed questionnaires showing the results of all the interviews which were conducted by me in respect of this survey in Dartford."

11. I note that the declarations of Mr Miller and Ms Rodrigues are in virtually identical terms

to those of their colleagues completing the respective surveys (Mr Benson in the case of Mr Miller and Mr Kotzur in the case of Ms Rodrigues) varying only to the extent necessary to identify the number of members of the public they interviewed (16 in the case of Mr Miller and 38 in Ms Rodrigues's case). The conclusions to be drawn from the results of these two surveys from the opponents' standpoint is contained in Mr Benson's declaration above; I shall return to this survey evidence later in my decision.

Applicants' evidence-in-chief

12. This consists of four declarations. The first dated 2 March 2000 is by Berenice Patricia Bella Harris. Ms Harris is a registered trade mark agent and a solicitor in the employ of Carpmaels & Ransford. The purpose of her declaration is to have admitted into these proceedings a declaration and exhibits made by her and dated 1 March 2000 which were originally filed in related opposition proceedings No 47934. These documents are attached to her declaration as exhibit BPBH-1.

13. In her declaration Ms Harris explains that she has undertaken or arranged for various searches to be carried out to show the use made of KINDER in the United Kingdom. The nature of these searches were as follows:

(1) An on-line search of Yellow Pages on the Internet for businesses which included the word KINDER. A copy of the search report is provided as exhibit JDM1 to the declaration of James Dominic Moore to which I shall refer later in this decision. Having used the “?” symbol to reveal the nature of the business, Ms Harris explains that the report was annotated accordingly. Having explained the limitations of the search system used (to the effect that the search only revealed businesses where KINDER forms part of the first word or entry or where the first word is an initial or preposition), Ms Harris concludes that the search shows widespread use throughout the United Kingdom of KINDER in the context of businesses related to children.

(2) On-line searches on the Companies House web site for companies using the word KINDER in their names. Ms Harris explains that she searched in the “Companies Name & Address Index with Basic Company Information” entering KINDER against “Company/Branch name” in the search engine and selected searches in respect of (1) Current/Recently Dissolved names, (2) Previous names and (3) Dissolved names. Copies of the list of “Current/Recently Dissolved names” and the list of “Previous names” together with attached company particulars are provided as exhibits JDM2 and JDM3 to the declaration of Mr Moore. Exhibit BPBH8 consists of a copy of the list of “Dissolved names”. Ms Harris explains that as these were all dissolved companies which could not be contacted for further information individual company searches were not performed. However she notes from the list of “Dissolved names” that in many cases KINDER was used in the context of a business related to children.

(3) Search International were instructed to carry out a United Kingdom “Common Law” search for KINDER to include use as a business name, trade mark or descriptively in respect of any goods or services related to children. A copy of the search report is provided as exhibit JDM4 to the declaration of Mr Moore.

14. Ms Harris explains that the reports mentioned above were passed to Mr Moore with instructions to telephone as many of the businesses as he could with a view to establishing whether the businesses or products were child-related, how long KINDER had been used in the name and why it was chosen. While not summarised here, Ms Harris explains in detail the manner in which the various reports were annotated by her prior to them being given to Mr Moore. She adds that she also asked Mr Moore to inspect the 1994 telephone directories maintained by British Telecom Archives and to obtain copies of any entries for businesses which included KINDER in their name; Mr Moore was asked to cover as many regions as possible. Copies of Mr Moore's investigations in this regard are provided in exhibit JDM6 to his declaration.

15. Finally Ms Harris explains that Search International were instructed to carry out a United Kingdom "Similarity Search" in respect of EUKAL in Classes 5 and 30 to establish to what extent third parties might have pending or registered trade marks in or covering the United Kingdom similar to the EUKAL part of the applicants' mark. A copy of the report is provided as exhibit BPBH11 with Ms Harris concluding from it that EUKAL is highly distinctive for the goods covered by the application.

16. In so far as the searches mentioned above are concerned, Ms Harris comments:

"I believe that it is apparent from the searches carried out on behalf of the applicant that KINDER is widely understood and used throughout the United Kingdom as referring to children and that this was also the case at the date of the application in suit."

17. The second declaration dated 2 March 2000 is by James Dominic Moore. The purpose of his declaration is to have admitted into these proceedings a declaration and exhibits made by him and dated 1 March 2000 also originally filed in related opposition proceedings No 47934. This is attached to his declaration as exhibit JDM-1.

18. In his declaration Mr Moore explains that he is a trainee trade mark agent in the employ of Carpmaels & Ransford. Mr Moore states that he has been assisting Ms Harris who has the conduct of these proceedings on behalf of the applicants for registration. He explains that on 18 February 2000, Ms Harris gave him copies of the documents mentioned in her second declaration above. Mr Moore explains that Ms Harris suggested the businesses which he might contact by annotating the pages accordingly; he confirms the instructions given to him by Ms Harris which included not contacting the list of Kindergartens from the Search International Report or any business where it was clear that the name of the business clearly derived from the name of an individual or where the business clearly would not be related to children. Having obtained in so far as was possible the telephone numbers of the companies on the respective lists, Mr Morris explains that he contacted the companies concerned identifying himself as a trade mark agent who was conducting a survey of companies that included KINDER in their name. Not surprisingly, Mr Morris was not able to obtain information from all the companies he contacted. Of those who were willing to assist, he asked the following questions; (1) what is your company's business? (2) how long has your company used a name that contained KINDER? (3) why was the company name that included the word KINDER chosen? (4) the name of the person to whom Mr Moore spoke. The

results of his investigations are provided in exhibit JDM5. I note that in response to question (3), the majority of the responses suggest that the name was chosen because it means or relates to children.

19. Mr Morris explains that in so far as the Search International Report was concerned, that he tried on 25 February 2000 to contact the businesses responsible for the following products: KINDERVITAL, KINDERVITAL P.R.O.D., KINDERGUARD, KINDERBOX, KINDER WORLD and KINDERCRYL. Mr Moore provides the results of these investigations and comments:

“On the various occasions when the persons to whom I spoke answered to the effect that KINDER means children in German, I formed the impression, from the way they said this, that they thought that this was obvious and well-known.”

20. In so far as Mr Moore was asked to obtain copies from the BT Archive of extracts from BT telephone books for 1994 which showed entries for businesses which included KINDER in their name, Mr Moore explained that he visited the BT Archive in High Holborn, London on 22 February 2000. During his visit explains Mr Moore he reviewed the 1994 London Business Pages and regional 1994 BT telephone books, although because of time constraints he was unable to review all of the documents and selectively ignored some of the rural Scottish and Welsh directories. Exhibit JDM6 consist of copies of pages from the various 1994 telephone directories showing business names beginning with KINDER.

21. The third declaration dated 16 February 2000 is by David John Rickard. Mr Rickard confirms his position as a trade mark agent, solicitor and a partner in the firm of Boulton Wade Tennant. He confirms that his declaration is based on his own knowledge and on documents to which he refers. Paragraphs 2 to 6 of his declaration are reproduced verbatim below:

“2. Now produced and shown to me marked exhibit DJR1 are copy extracts from the 1997 edition of Statistisches Jahrbuch produced by Statistisches Bundesamt. The extracted page 273 relates to tourism in Germany. On page 273 numbers of tourists visiting Germany from various countries are shown for 1996. 1,350, 400 tourists from the UK, including Northern Ireland, visited Germany. 2,946,700 nights were spent by UK tourists in Germany. Extracted page 82 shows the number of Germans emigrating to various countries. In 1996 in excess of 20,000 Germans migrated to the United Kingdom (including Northern Ireland). Also included in exhibit DJR-1 is a copy extract from the 1997 edition of the Austrian Tourist Office Annual Report. In 1997 531,926 tourists from the UK visited Austria. 2,478,040 nights were spent by UK tourists in Austria in 1997.

3. Now produced and shown to me marked exhibit DJR-2 are copy extracts from two books available in the United Kingdom namely “German In Three Months” published by Hugo’s Language Books Limited and “Ealing Course in German” published by Longman. These books teach German language to English speakers. I note from the “German-English vocabulary” section of the Hugo book that the word “kinder” means “child”. Lesson 1 of the Hugo book deals with the general principles of speaking German and in particular, “the alphabet, spelling and pronunciation, vowels and

vowel combinations, consonants, punctuation and stressed syllables". Lesson 2 deals with "greetings, every day phrases", "gender" and other basics. In lesson 2, the reader is introduced to certain German words. On page 23 the word "kind" is taught and is said to mean "child". On page 24 the reader is taught the plural of the noun is "kinder". This lesson includes various exercises which make reference to the words "kind" and "kinder". In the Longman book, the reader is introduced to the word "kinder" in lesson 3. In both books, the word "kinder" is introduced at an early stage in the lessons programs.

4. When studying for European Patent Examinations, I learnt some German language. One of the earliest words which I learnt was "kinder" meaning "child". I believe that this word is taught to students learning the German language at an early stage in most cases in the UK. The word "kinder" is one of the German words which I still recall from my lessons including its meaning of "child". This word has made its way into the English language in words such as "kindergarten".

5. Also included in exhibit DJR-2 is a copy extract from the Times Educational Supplement of 28 August 1998 listing the numbers of students who sat various GCSE exams in 1997 and 1998. German was the second most popular foreign language subject and apparently the tenth most popular course overall. I note that the total number of students who sat the exam for German in 1998 was 133,683. The number of 1997 was 132,615.

6. Now produced and shown to me marked exhibit DJR-3 is a copy extract from the Shorter Oxford Dictionary. The word "kind" is a well known English word and the word "kinder" is a variation of the word "kind". It means more "acceptable, gentle, agreeable, soft". I also note that the German word is listed with its English meaning of "children" thereby establishing that it is recognised generally in the UK. Also included in Exhibit DJR-3 are copy extracts from Dutch-English, Afrikaans-English, German-English and Spanish-English dictionaries. Each of these shows that the word "kind" and "hence "kinder" are words in these languages."

22. The relevant points emerging from the remainder of Mr Rickard's declaration are, in my view, as follows:

- that in view of the comments in Ms Wooll's declaration to the effect that only six products have been sold under the KINDER mark in the United Kingdom, Mr Rickard concludes that Ferrero and/or Soremartec have not used in excess of 50 of the trade marks listed in their Statement of Grounds;
- exhibit DJR-5 consists of copies of letters dated 28 November 1997 and 2 June 1999 received by his firm from the Office for Harmonisation in the Internal Market (OHIM) in response to an application to register the trade mark KINDERCARE. Mr Rickard notes that the Examiner in rejecting the application stated that "kinder is a German word known throughout the Community to mean "child" or "children", that the trade mark "conveys a simple and obvious descriptive meaning" and that the combination is desirable for other traders to use in the course of trade as a descriptive indication. The

mark nonetheless would be readily understood in English, German and Dutch as being primarily descriptive. The mark merely indicates goods and services for children which involve care or caring”;

- exhibit DJR-7 is said to consist of copies of Decisions of the German Patent Office together with English translations. However only copies of the documents relating to the trade mark “kinder eukal” are provided. The Decision dated 25 July 1997 relates to an opposition by Ferrero to registration of the trade mark KINDER EUKAL. Mr Rickard refers to the following passages from the Decision:

“In the present case, the first element “kinder” of the multiple word mark points out to the addressed consumers i.e. children, the particular suitability of the goods marked this way in a descriptive manner and is not suitable to shape the attacked mark by itself. The addressed consumers will not be enabled to make reference from the word “kinder” the place of origin on the goods labelled with the trade mark in dispute and, therefore, such consumers will base their distinction of this trade mark.....predominantly upon the element “eukal”. For this reason, the risk may be neglected that the addressees will compare the element “kinder” separated from the rest with the prior trade mark. Thus a direct risk of confusion can be denied. In addition, there is no risk that the attacked mark may be associated with the opposing mark.”

“In view of the insufficient distinctiveness of the word “kinder” it lacks the suitability to serve as a reference necessary to infer to the identical place of origin of the goods”.

- although copies are not provided, Mr Rickard also refers to Decisions of the German Patent Office in cases S112/97 and S175/96. He explains that in S112/97 the German Patent Office held that registration No 39610402 for a stylised representation of the words FUR-KINDER was invalid. Mr Rickard says that it was held that “the trade mark (FUR-KINDER) is devoid of the necessary minimum degree of distinctiveness” stating that “the word elements have a mere factual character” and the registration was cancelled. The Patent Office held “on its own the words FUR-KINDER obviously represent a statement of determination, as children form the preferred target for the products in question ie. confectionery, and as such goods with respect to their composition, taste and presentation are frequently in particular designed to the needs and desires of children”. He adds that the Patent Office went on to hold that “it is also conventional to refer to such kind of determination within the product group “confectionery” by way of a determination like “FUR-KINDER”. Consequently, it can be held that competitors have a great interest in having these words reserved for free use of all.”
- in so far as the Decision in S175/96 is concerned, the German Patent Office held that trade mark No 39610406 CHILDREN’S CHOCOLATE should be cancelled. The Office held that “on its own the words CHILDREN’S CHOCOLATE originating from the English language represent a typical description of goods with the meaning

“chocolate for children”. It held that “children form a preferred target group for the goods of the type claimed” “hence, for the concerned goods, which may all be made of chocolate or at least may contain chocolate, the attacked mark merely contains a reference to chocolate products, which are in particular intended for or suitable for children. This is easily comprehensible for the major part of the domestic consumers”;

- exhibit DJR-8 consists of copies of various web sites which include KINDER in connection with children together with a list of companies in the United Kingdom which include KINDER in their name;
- exhibit DJR-9 consists of copy extracts printed from a search of a CD provided by BT containing telephone listings for the UK, the results of a search of Yellow pages on the Internet and copy extracts of various BT telephone directories published in 1997 for areas of the United Kingdom all in relation to the word KINDER. Mr Rickard estimates that the directories searched constitute approximately 60% of the BT directories covering the United Kingdom. Mr Rickard notes that the names of some of the entries describe the nature of the business and adds that on 16 February 2000 his assistant Julius Stobbs telephoned a number of entries from the list to establish the nature of their business. Of the ten companies Mr Stobbs contacted, I note that all were involved with goods and services relating to children.

23. The final declaration dated 17 February 2000 is by the same David Rickard mentioned above. Exhibit DJR-10 to his declaration consists of details of United Kingdom and Community trade mark registrations which include the word KINDER which are not owned by the opponents in these proceedings.

Opponents’ evidence-in-reply

24. This consists of a witness statement dated 2 August 2000 by Martin Krause who is a trade mark agent and a partner in the firm of Haseltine Lake Trademarks who are the opponents’ professional representative in these proceedings. In paragraph 1 of his witness statement Mr Krause says:

“Unless otherwise stated, the Declaration is based on my own knowledge or is derived from other documents to which I refer specifically. I am also a German speaker with a good knowledge of the German language.”

25. Mr Krause divides his response to the applicants’ evidence into a number of sub-headings drawing conclusions where appropriate. He begins by reviewing the **meaning of the word KINDER**. Exhibit MHK1 and MHK2 are respectively, copies of page 854 of the Collins English Dictionary (third edition) 1994 which says Mr Krause lists all words in the dictionary commencing with the letters KIND and pages 472 and 473 of the Oxford Pocket Dictionary (sixth edition) dated 1978 showing, he says, the same results as the Collins dictionary. Mr Krause accepts that the word “kind” is widely known as the comparative form of the adjective “kind”. In so far as Mr Rickard relies on an extract from New Shorter Oxford Dictionary, Mr Krause notes that two entries incorporating the word kinder are

identified, these are: KINDER, KIRCHE, KUCHE and KINDERSPIEL. Of these entries Mr Krause says:

“I am unaware of any use of either the above phrase or the above word in common parlance. I am aware that the New Shorter Oxford English Dictionary includes a number of references to obsolete, archaic and dialectal words, as well as many words and phrases which, though still in occasional use, are used only by a very small minority of the population. I believe, therefore that the phrase KINDER, KIRCHE, KUCHE and the word KINDERSPIEL are now either obsolete in the English language or are used only by a very small minority of the population of this country”

and he concludes that there is no indication that the word “kinder” had “made its way into the English language” at the relevant date, other than as the comparative form of the English word “kind”.

26. In relation to the **use of the word KINDER**, Mr Krause notes that only the search of the 1997 telephone directories referred to in Mr Rickard’s declaration reflect the position at the material date in these proceedings. Mr Krause comments that it is apparent from the searches that the word “kinder” is a surname adding that the search reveals only five businesses in the London area and around one hundred businesses elsewhere whose names consist of or commence with the word “kinder”.

27. In so far as **the word EUKAL** is concerned, Mr Krause notes the comments of Ms Harris when she said:

“I believe that it is clear from this report that EUKAL is highly distinctive for the goods covered by the application.....”.

28. Exhibit MHK3 consists of an extract taken from the Oxford Duden German Dictionary showing the entry for the German word “Eukalyptus”, which means in English “eucalyptus”. Mr Krause comments that the word EUKAL appears, therefore, to be derived from the first two syllables of the German word “Eukalyptus” and in his view is phonetically identical with and visually almost the same as the first part of the English word “eucalyptus”.

29. That concludes my review of the evidence filed in so far as I consider it necessary.

DECISION

Section 3 Objections

30. In his skeleton argument Mr Edenborough helpfully indicated that the objections based on any inherent defects in the marks would not be pursued at the hearing. However, he did not have instructions to abandon the grounds with the result that they could not be formally withdrawn. Mr Arnold submitted that the grounds were hopeless and indicated that as a consequence, he would not be making submission in relation thereto.

31. As a result, I do not need to say a great deal about these objections. The basis for them is not made clear beyond the bare claims in the statement of grounds. In practice I can see no obvious basis for any of the objections based on the ‘absolute ground’ provisions of the Act and dismiss them accordingly.

Section 5 Objections

32. Taking these in order, Section 5(2)(b) reads:-

"5.(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

33. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

34. Mr Edenborough’s skeleton argument summarised the opponents’ position in the following terms.

“In this case, the proposed mark contains the word “kinder”, which is identical to Ferrero’s mark KINDER. Moreover, there is clear evidence of (a) a family of marks that all contain the mark KINDER (as held by the CTM Opposition Division in decision No 1082/2001 of 27 April 2001 in proceedings between the same parties); and (b) a reputation in the mark KINDER. The goods in question are either identical or similar, or if held to be dissimilar, then only just so. Thus, the basis for Section 5(2)(b) are established, and so section 5(4)(a) follows (the absence of any actual instances of misrepresentation is due to the fact that Soldan’s products are not yet on the market, and no test marketing was conducted).”

The opponents’ marks and the distinctive character thereof

35. There is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it (*Sabel v Puma*, paragraph 24). The requirement to consider both the inherent and acquired character of the opponents’ marks necessitates a review of the evidence that is before me bearing on these issues. It is substantially the same as that filed in the related oppositions under the 1938 Act.

36. For convenience my analysis of that evidence as contained in the related oppositions is reproduced as Annex B to this decision. I regard those findings as being largely applicable to the current case. However, two main considerations require me to revisit the evidence - the law itself has changed and the material date, 1 July 1997, is some three years later than the filing date of the applications under the 1938 Act.

37. In so far as the law itself is concerned the only issue that arises in relation to the analysis in Annex B is the reference to EL CANAL DE LAS ESTRELLAS which was a decision under the 1938 Act. However, the principles set out in that case were adopted as being equally applicable under the new law in TONALITE HENNE Trade Mark application, a decision of Mr S Thorley QC, sitting as the Appointed Person (O/485/00).

38. The later filing date of the application in suit is of rather greater potential significance in view of the opponents' continuing use of their marks in the interim period. The main additional points I draw from the evidence and which are relevant to this case are:

- the mark KINDER JOY was brought into use for another chocolate product with sales of £143,467 for the period September 1995 to August 1996 and £549,527 for the period September 1996 to August 1997. A significantly larger volume of sales in the following year took place after the relevant date.
- sales figures for the other brands are only given up to 1995/6 and advertising figures up to 1996/97.
- sales of KINDER SURPRISE continued to grow. Sales of KINDER CHOCOLATE and KINDER BUENO were at low levels and on a downward trend. Sales of KINDER MAXI appear to have been discontinued. KINDER MILK SLICE sales continued at a slightly reduced rate.
- the promotional spend largely mirrors the above trend.

39. The other point that needs to be made is that the surveys conducted in September 1998 are little more than a year after the filing date of the application in suit and, therefore, more closely reflect consumer perception at the relevant time.

40. With the material in Annex B and the above comments in mind I summarise my finding as being that:

- the opponents have significant use of, and reputation in, the mark KINDER SURPRISE in relation to a chocolate egg product.
- there is insufficient evidence for me to be satisfied that there is a significant degree of consumer awareness of the opponents' other KINDER products. In fact a number are likely to have a diminishing degree of public prominence and, in the case of KINDER MAXI, to have disappeared from view altogether.
- the marks are used on single products only.

- the range of goods is narrow being largely restricted to chocolate products (KINDER MILK SLICE being the only exception).
- there is no evidence of other traders using KINDER in the confectionery field, but it is used in other areas in relation to products or services for, or directed at, children.
- Kinder is a common word of the German language.
- it cannot be said to have also passed into the English language but is nevertheless a word that is likely to command a reasonable degree of recognition in this country even amongst people who would not claim to speak or generally understand much German.
- the inherent merits of the word are likely to be relatively low particularly if used in relation to goods suitable for, or directed at, children and the degree of protection to be accorded to it should be judged accordingly.
- the manner and prominence of presentation of the word and the context in which it is used are likely to have a bearing on consumer perception of the word (that is to say whether it is being used as a trade mark or in a descriptive sense).

The issues to be considered under Section 5(2)

41. The opponents are entitled to have their position tested under Section 5(2)(b) on the basis of each and every one of the registrations referred to. In practice it is not, in my view, necessary to approach the matter in quite this way and neither Counsel has suggested I should do so. The opponents' position can be adequately tested on the basis of the following:

- (i) the mark KINDER solus registered under nos 1170775 and 1393756 for the following specifications of goods:
 - Chocolate and chocolate products (for food) - Class 30
 - Milk, milk shakes, yoghurt, ice cream, whipped cream; all being chocolate flavoured - Class 29;
- (ii) the mark KINDER SURPRISE which is likely to enjoy a reputation in relation to the opponents' chocolate egg product;
- (iii) the claim to a family of marks containing the word KINDER.

42. The opponents are unlikely to be in any better position on the basis of any of their other individual marks.

Comparison of the trade marks

43. The matter is to be judged through the eyes of the average consumer who is deemed to be reasonably well informed and reasonably circumspect and observant but who rarely has the chance to make side by side comparisons of marks but must instead rely upon imperfect recollections of them (Sabel v Puma paragraph 23 and Lloyd Schuhfabrik v Klijsen Handel, paragraph 27). Furthermore the average consumer usually perceives a mark as a whole and does not proceed to analyse its various details (Sabel v Puma, paragraph 23). The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (again Sabel v Puma, paragraph 23).

44. The applied for mark consists of a device of a child holding a card with the words EUKAL FÜR KINDER on it though it is important to bear in mind the precise form and prominence given to those words in the mark applied for. Visually the largest single component of the mark is the child device. It is a stylised, cartoon-like, representation of a child. The words EUKAL and FÜR KINDER are presented in different typefaces. EUKAL is not only the first element, it is also visually the most prominent element, a state of affairs which is accentuated by the fact that it is presented in a bolder script. The words FÜR KINDER seem to me to make at most a marginal contribution to the overall character of the mark.

45. In relation to the broadly similar mark that is the subject of Opposition No 47934 Mr Edenborough submitted that, as EUKAL had no conceptual meaning, the natural inclination would be for consumers to focus on the only word that they would recognise, namely KINDER.

46. For the same reasons as I have given in Opposition No 47934 I have some difficulty in accepting Mr Edenborough's reasoning on this point. It is usually said that consumers do not pause to analyse marks in this way. Rather they consider marks on the basis presented to them and (subconsciously) form their own view as to what is or may be trade mark matter and what is or may be descriptive matter. Furthermore they are used to encountering words that they may not recognise or attribute a meaning to. Often the strongest trade marks are invented words (eg Kodak, Nike).

47. The overwhelming visual impression left by the applicants' mark is that of the device of a child holding a card with EUKAL written on it. Those are the elements that seem to me to stand out and provide the most obvious points of reference for anyone viewing the mark. In short they are the distinctive and dominant components.

48. The same would also be true in terms of oral references to the mark. Where composite marks are concerned there may be room for doubt as to what extent (if any) reliance will be placed on device elements in oral references to the mark. The device here is not an abstract one and is perfectly capable of being described for what it is but, if that does not happen, it seems reasonable to suppose that the mark would primarily be referred to by reference to the word EUKAL. However, bearing in mind the nature of the goods, I would expect purchases

to be based largely on a visual selection process at point of sale where the device element comes into its own.

49. This is not to suggest that the words FÜR KINDER would go unnoticed or be ignored as a de minimis element within the mark. I am, however, of the view that this element would play a minor role in terms of the features which individually or collectively would imprint themselves in the mind of the consumer. Moreover, given the potential descriptive significance of the words and their subordinate position and presence in the mark, it strongly suggests that they would not be seen, in context, as either a distinctive or dominant element of the mark in the sense that reliance would be placed on them as indicating trade origin.

50. Turning to the comparison itself, the opponents' strongest case is arguably based on their registration of KINDER solus. This mark has been used in relation to chocolate but, on the evidence before me (with sales reducing from £244,685 in 1993/4 to just £4,685 in 1995/6), the opponents cannot realistically expect this mark to benefit from any enhanced reputation. It does, nevertheless, form part of the element FÜR KINDER in the applied for mark or, to put the matter another way, is wholly contained in that mark.

51. I am required to consider the issue of similarity from a visual, aural and conceptual standpoint. When the applied for mark is considered in its entirety I find that the overall visual impression is quite different from the word KINDER on its own. The factors contributing to this are the composite nature of the applied for mark, the relative importance of the constituent elements and the context in which the words FÜR KINDER are used. As suggested above, it seems highly likely that oral references to the applicants' mark will focus on the word EUKAL and/or the device though with goods of the kind at issue a visual selection process at the point of sale is likely to be the norm. Conceptually, even if the common element is noted, I do not consider it renders the respective marks similar given the low inherent distinctiveness of the word KINDER and its context/prominence within the applied for mark.

52. The second of the opponents' marks which requires consideration is KINDER SURPRISE. I have singled this mark out because the opponents have enjoyed long and significant use of this mark dating back to 1980/81 (Exhibit VW3) with sales in the most recent year available (1995/6) of £13.7 million. The latter figure has admittedly not been placed in context in relation to the size of the chocolate confectionery market or the confectionery mark at large. But it is used on a single product only and appears to enjoy a measure of public recognition (even allowing for the deficiencies in the surveys). The opponents thus have some claim to an enhanced degree of distinctive character for this mark.

53. However taking the matter in the round these considerations do not in my view outweigh the obvious differences in the visual, aural and conceptual comparison between KINDER SURPRISE and the mark applied for. The point of similarity remains the word KINDER. There may be mixed consumer reaction to that word when it is used in combination with the English word SURPRISE. That is, it might be seen as either a German/English or English/English combination. Either way when the totalities of the marks are considered I am of the clear view that they cannot be said to be similar.

54. Mr Arnold drew support for such a finding from 10 ROYAL BERKSHIRE POLO CLUB TRADE MARK [2001] RPC 32 page 643 where that mark was opposed by the proprietors of the mark POLO. The Appointed Person's view of the matter is reflected in the following extract from the headnotes to the case:

"(11) The use of the word POLO in the applicant's mark did not capture the distinctiveness of the opponent's earlier trade marks. People exposed to the applicant's mark would notice that it contained the word POLO and would also notice that it contained ROYAL BERKSHIRE and CLUB. The message of the applicant's mark came from the words in combination and that was not something that people would overlook or ignore in the ordinary way of things.

(12) The word POLO functioned as an adjective in the applicant's mark but would be perceived as a noun in the opponent's mark. Adjectival use of a word was distinguishable from use as a noun and the resulting differences might, and in this case were, sufficient to preclude a likelihood of confusion."

55. It is true that circumstances here do not precisely match those set out in (12) above but the point remains that words must be seen in context. Soldan can reasonably say that they are using a common descriptive word of the German language in a manner and context which removes the risk of similarity with the opponents' marks.

56. Finally there is Mr Edenborough's submission that the opponents have a family of KINDER marks. He supported this claim by reference to a decision of the OHIM Opposition Decision in Case No 1082/2001. The permissibility of considering a submission based on a family of marks was considered in The Infamous Nut Company Limited's Trade Mark application (Opposition by Percy Dalton (Holdings) Limited), in a decision by Professor R Annand, sitting as the Appointed Person, (O/411/01). She concluded that:

"It is impermissible for Section 5(2)(b) collectively to group together several earlier trade marks in the proprietorship of the opponent.

Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by Section 6). Thus where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant's mark must be considered against each of the opponent's earlier trade marks separately (ENER-CAP Trade Mark [1999] RPC 362).

In some circumstances, it may be possible for the opponents to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a "family of marks" in the proprietorship and use of the opponent (AMOR, Decision No 189/1999 of the Opposition Division, OHIM OJ 2/2000, p 235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31."

57. The OHIM Opposition Decision relied on by Mr Edenborough was decided on its own

facts. In particular, as Mr Arnold noted, the evidence that influenced the decision was, it seems, based on a survey of the Italian public. Italy is Ferrero's home market where their position can be expected to be at its strongest. This is borne out by the results of a market survey in that case which established significant levels of consumer awareness of some nine KINDER marks (see pages 11 and 12 of the decision). The outcome of the OHIM decision cannot, in itself, determine the position in the UK.

58. A claim that an element in a mark has particular recognition because it is common to a family of marks requires the common element to be in use and that the public places some reliance on it. It seems to me that establishing such a claim is likely to depend on numerous factors including the number of marks used, the extent of use and the nature of the element that is said to be the common feature.

59. Mr Arnold noted that the opponents' survey evidence established some recognition of their KINDER SURPRISE chocolate egg product but not of the other marks used. That is largely the case but the nature of the first survey was such that interviewees were always likely to identify the best known example of a KINDER product they had encountered. Generally, however, the surveys are not sufficiently robust to be able to rely on them as being properly indicative of the level of recognition enjoyed by the KINDER marks in this country. It is also clear from some of the responses to the second survey that a number of interviewees were basing their responses on the fact that they had encountered KINDER marks in other countries.

60. The failure of the survey evidence to establish recognition of the opponents' other KINDER marks may not in itself be fatal to the opponents' family of marks claim. It is necessary to also consider the opponents' evidence of use to gauge the extent to which the public has been exposed to, and recognises, a family of KINDER marks (that is in addition to KINDER SURPRISE). The principal evidence is Ms Wooll's declaration and exhibits. I note firstly that the packaging (VW1) shows the mark KINDER being used in a particular form with K in black and the remaining letters in red. In terms of use of individual marks the picture is mixed. KINDER MAXI appears to have had a relatively short lifespan with no sales at all after 1993/4. It can have made little, if any, impact on consumers. KINDER CHOCOLATE and KINDER BUENO appear to have enjoyed modest sales but were both on steeply declining sales paths by 1995/6. Their continuing impact is uncertain. KINDER JOY is a more recent introduction (September 1995). Again its impact by the material date in these proceedings is hard to assess. As noted earlier in this decision there is nothing to place the sales or promotional figures in context within the chocolate confectionery market or to assess their effect on consumers. There is also KINDER MILK SLICE but that mark is used on a different product, and I have no basis on which to assess how or whether it contributes to the family of marks' claim. I bear in mind also that the element relied on by the opponents as a basis for the claim is itself of low inherent distinctive character. I am unable to conclude from these circumstances that the opponents have made good their claim to a family of marks.

Comparison of goods

61. The applicants accept there is an overlap of goods between their Class 30 specification

and the opponents' registrations. The term 'confectionery' for instance will include chocolate and other items that are identical to the opponents' goods. Other items in Class 30 are likely to be similar.

62. The position in Class 5 is less straightforward. By definition the goods cannot be identical (the opponents have no Class 5 registration). On the other hand medicated confectionery products in Class 5 (medicated candy, lozenges, pastilles etc) are likely to be similar to their non-medicated equivalents in Class 30. The remaining Class 5 goods are largely pharmaceutical and sanitary preparations for the treatment of ailments and are dissimilar, therefore, on the basis of the CANON test, to the opponents' goods.

63. Further detailed analysis of the goods is in my view unnecessary and was not in any case the primary subject of submissions at the hearing. If the opponents do not succeed on the basis of identical goods they will not do so on the basis of similar goods.

Likelihood of confusion

64. In *Raleigh International Trade Mark*, [2001] RPC 11 page 202 Geoffrey Hobbs QC, sitting as the Appointed Person, indicated that:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under Section 5(2) must be to determine the net effect of the given similarities and differences. According to *Lloyd Schuhfabrik* paragraph 19:

“A lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks and vice versa”.

According to *Canon* paragraph 24:

“The distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion”.

It follows that an objection can succeed under Section 5(2) on the strength of the distinctiveness and reputation of the earlier trade mark, even if people might not otherwise (ie apart from the use of the marks in contention) expect the same undertaking or economically-linked undertakings to be supplying goods or services of the kind in contention.”

65. I have considered the matter on the basis of the marks KINDER and KINDER SURPRISE which, for different reasons, offer the opponents their best chance of success. I have concluded that the word KINDER is in itself of low distinctive character and meaningful in relation to goods for children. Further, there is likely to be a reasonable degree of recognition of the (German) word in this country. In these circumstances the context,

prominence and presentation of the element within the applicants' mark is important. On the basis of normal and fair use of the mark at issue I have reached the view that there is no likelihood of confusion even allowing for use on identical goods.

66. I do not propose to deal in any depth with the remaining grounds under Section 5(3) and 5(4)(a). It is unnecessary to do so. The statutory provisions are as follows:

“(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

67. The starting point for an objection under Section 5(3) is an earlier trade mark that has a reputation. The requirements in this respect are set out in *General Motors Corp v Yplon SA* [1999] ETMR 950 (Chevy). In particular it is said that:

“26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

68. The only one of the opponents' marks that could conceivably be regarded as meeting the stringent criteria set out in Chevy is KINDER SURPRISE. I have already considered that mark in relation to Section 5(2)(b) and concluded that it is not similar to the mark applied for.

The Section 5(3) case must, also, fail at the outset for the same reason.

69. The Section 5(4)(a) objection appears to add nothing to that under Section 5(2)(b). The marks considered under the latter are the same as the marks used (assuming that the opponents' use of their marks in a particular colour scheme falls within normal and fair use of the marks as registered). No additional issues arise. The opponents will be unable to establish the second leg of the passing off test, namely misrepresentation.

70. The applicants have been successful and are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £1300. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19TH day of July 2002

**M REYNOLDS
For the Registrar
The Comptroller General**

United Kingdom Trade Mark Registrations owned by Ferrero S.p.A. & Soremartec S.A.

No	Trade Mark	Class	Application Date
1170775	KINDER	30	03/03/1982
1393756	KINDER	29	02/08/1989
1117389	KINDER JOY (Expired)	28	11/07/1979
1117390	KINDER JOY	30	11/07/1979
1190606	KINDER SURPRISE	30	16/02/1983
1203542	KINDER FRESCO	30	16/09/1983
1357980	KINDER MILK SLICE	30	23/09/1988
1393751	KINDER SURPRISE	30	02/08/1989
1471898	KINDER SCHOKO-BONS	30	29/07/1991
1474992	KINDER DELICE	30	29/08/1991
1489981	KINDER SNAPPY	30	05/02/1992
1492502	KINDER SOFTY (+ device)	30	28/02/1992
1508672	KINDER CIRCUS	30	05/08/1992
1525450	KINDER CHOCOLATE (+ device)	30	01/02/1993
905725	KINDER SCHOKOLADE FERRERO (+ device) (Expired)	30	21/02/1967
928392	KINDER CHOCOLATE (+ device)	30	22/07/1968
958455	FERRERO KINDER	30	20/04/1970
1296561	KINDER SUN DRINK (stylised)	29	24/12/1986
1296562	KINDER SUN DRINK (stylised)	32	24/12/1986
1280876	KINDER JUMBO SURPRISE (+ device)	30	02/10/1986
1269665	KINDER COUNTRY (stylised)	30	16/04/1986
1267242	KINDER BUENO (stylised)	30	16/05/1986
1260493	KINDER MILK-SANDWICH (stylised)	30	16/12/1985
<u>No</u>	<u>Trade Mark</u>	<u>Class</u>	<u>Application Date</u>
1245781	KINDER MILK-BREAK (stylised)	30	10/07/1985
2124572	KINDER MAXI (+ device)	30	24/02/1997
1226610	KINDER SOFTY (stylised)	30	03/07/1984
1373988	KINDER TIME (+ device)	29	22/02/1989
1440569	KINDER CUORDIFRUTTA (stylised)	30	07/07/1990
1440579	KINDER PINGO (stylised)	30	07/09/1990
1507498	KINDER CHOCO BLANC (+ device)	29	22/07/1992
1507499	KINDER CHOCO BLANC (+ device)	30	22/07/1992
1524541	KINDER PINGUI	30	22/01/1993
1529869	KINDER PINGUINO (Archived)	-	-
1529878	KINDER PINGUI (Archived) -	-	-

1298128	KINDER SOFTY (stylised)	30	19/01/1987
1326031	KINDER DAYLICIOUS	30	18/05/1987
1541165	KINDER TIME	30	08/07/1993
1541166	KINDER TIME	32	08/07/1993
1560119	KINDER HAPPY HIPPOS SNACK	30	25/01/1994
1561631	KINDER HAPPY EGGS (+ device) - (Expired)	30	08/02/1994
1569173	KINDER HAPPY HIPPO SNACK (+ device)	30	19/04/1994
1569175	KINDER HAPPY EGGS (Expired)	30	19/04/1994
1569226	KINDER TONUS	30	19/04/1994
1569247	KINDER SCHOKO-BONS (+ device)	30	19/04/1994
1573811	KINDER CROKO-KISS (Expired)	30	01/06/1994
1579263	KINDER PINGUI (+ device)	30	22/07/1994

<u>No</u>	<u>Trade Mark</u>	<u>Class</u>	<u>Application Date</u>
2011082	KINDER OVETTO (stylised)	30	14/02/1995
2030347	KINDER KING	30	14/08/1995
2125682	KINDER PROF. RINO	30	06/03/1997
2122787	KINDER MILK SLICE (+ device)	30	05/02/1997
2147366	KINDER PROF. RINO (+ device)	30	08/10/1997

Extract from the findings in related opposition actions

That brings me to the core issue of the significance of the word KINDER which has been the subject of a large amount of evidence and submissions at the hearing. Put briefly, the opponents say that their KINDER mark has a reputation in the UK and, if a member of the public saw the same word upon another product, confusion is likely. The applicants take the contrary position that it is an ordinary word of the German language which has also become part of the English language; that it should be available to them for descriptive use; and that it would be understood in its descriptive sense if used in relation to products aimed at children.

Guidance on the correct approach to the registrability of words in foreign languages (for the purpose of Section 9 and 10 of the Act) can be found in EL CANAL DE LAS ESTRELLAS Trade Mark [2000] RPC 291. I am not concerned here with the registrability of the applicants' mark for Section 9 and 10 purposes (they have, in any case, disclaimed rights in the word KINDER) but I find the reported case of some assistance in terms of the general approach to words in foreign languages where, as here, a foreign language word is relied on by the opponents to prevent registration of the application in suit. The headnotes for EL CANAL DE LAS ESTRELLAS record that:

- “(1) There was no rule that foreign words had to be examined for registrability by reference to their meaning in translation. The purpose of translation was to ensure that foreign words were not registered without knowing their meaning.*
- (2) For registration, foreign words needed only to be capable of functioning satisfactorily as trade marks in relation to the goods or services supplied in or from the United Kingdom, whether or not they would also qualify for protection elsewhere.*
- (3) The less obscure a foreign word was, the greater the weight which had to be given to its meaning in translation.*
- (4) Traders engaged in intra-Community trade were not, unjustifiably, to be prevented from using words in the language of other member states of the European Union.*
- (5) Spanish was a modern language widely understood and spoken in the United Kingdom. Spain was a trading partner of the United Kingdom and a fellow member of the European Union. The services specified in the application were supplied nationally and internationally.*
- (6) EL CANAL DE LAS ESTRELLAS was easily recognisable as Spanish which when used in respect of the services specified would be understood as laudatory and not a reference to stellar bodies.*
- (7) The disclaimers offered did not cure the defects of the mark.”*

Whilst the above guidance provides a useful pointer to assessing the character of a word in a foreign language there are additional factors in the case before me dealing with the significance of the word KINDER and the nature and extent of the reputation attaching to the opponents' mark(s). On the opponents' side there is evidence of use and survey material dealing with public awareness and understanding of KINDER. On the applicants' side there is dictionary and other material intended to demonstrate that KINDER means 'children' and that it has entered the English language and would be understood as meaning 'children' in this country. There are also the results of various searches undertaken and purporting to show that KINDER is used in a meaningful way in a business context to denote products or services for, or relating to, children. Finally there are decisions of other trade mark offices suggesting that KINDER has a descriptive meaning. I go on to consider this material before drawing my own conclusions.

The opponents' evidence of use of their various KINDER marks is summarised above. At the material date in these proceedings sale of KINDER SURPRISE chocolate eggs had reached, and been maintained at, significant levels. KINDER chocolate and the KINDER MILK SLICE sponge bar products had also been available since 1986/7 with more modest levels of sales. KINDER MAXI and KINDER BUENO are more recent introductions to the range from about 1990/91 onwards though sales of the former appear to have been negligible in 1993/94 and to have ceased completely thereafter. There is no evidence before me to place the sales figures in a context which allows me to judge the success of individual products within the industry as a whole. It seems that each of the marks is used in relation to a single product only. With the probable exception of KINDER MILK SLICE all are chocolate products. Given the volume of sales, reinforced by the evidence from the survey (albeit that some caution is needed in interpreting the results - see below), I accept that the KINDER SURPRISE chocolate egg product enjoyed a significant reputation at the material date. I am less persuaded that the other KINDER products had made an impact at that time.

*In support of their position the opponents have filed the results of two surveys. The first (Benson/Miller) invited responses to questions concerning certain of the applicants' marks. The second (Kotzur/Rodrigues) was intended to establish the level of public awareness of KINDER. Both surveys were the subject of significant criticisms in Mr Arnold's skeleton argument and submissions at the hearing having regard to the leading authorities on the subject, *Imperial Group Plc v Philip Morris Ltd*, [1984] RPC 293 and *Scott Ltd v Nice-Pak Products Ltd*, [1989] FSR 100. The latter is relied on particularly in relation to circumstances where an applicants'/defendants' goods are not on the market.*

The main general criticisms of the surveys seems to me to be as follows:

- *they were conducted some four years after the relevant date. That may to an extent have been inevitable but it rendered the results unreliable to the extent that they would have been influenced by continuing and increased use by the opponents during the intervening period;*
- *the numbers interviewed were relatively small (45 and 40 respectively) and concentrated at a single location;*
- *there is insufficient information on the basis on which the agents charged with recruiting interviewees went about the selection process;*

- certain questions were of a leading nature and others invited speculation.

More particularly the Benson/Miller survey was conducted using a card with four of the applicants' marks on it, three of them being variant marks that are the subject of the three oppositions before me and the fourth a mark unrelated to the actions before me. It would seem that interviewees were also shown packaging for a mark that is not the subject of these opposition proceedings. Some of the marks shown to the interviewees had KINDER as a more dominant element than others. It is not possible to say to which mark or marks interviewees were reacting. The first question is of a leading nature referring as it does to the words in question being 'names of products' (products which are not it seems on the market in the UK). Question 4 reads:

"The names KINDER EM-EUKAL and EUKAL FÜR KINDER are to be used on various confectionery products, bakery products and medicines. You can see that the word "KINDER" is used on the packaging. What does the word KINDER mean to you?"

The first mark does not feature in any of the opposition proceedings before me and the words in the second strictly only in relation to the mark the subject of Opposition No 47934. More important still the question directs the interviewee to the word on which the interviewer wishes attention to be focussed.

The response to Question 2 ("Have you seen these products before?") of questionnaire No 14 in the interviews conducted by Mr Miller is recorded as being "Is it Kinder eggs? (Saw one on the table)". If the latter is representative of the circumstances in which the survey took place (ie with an example of the opponents' main product visible) that in itself must fatally undermine the value of the survey.

There are defects too in the Kotzur/Rodrigues survey. The first question was an ostensibly open one "What does the word KINDER mean to you?" The interviewees were at the same time shown a card with KINDER on it. Mr Edenborough was inclined to rely on the results as demonstrating unprompted awareness of the significance of KINDER in relation to his clients' products - of the 40 people questioned 27 said either chocolate, egg, chocolate egg or Kinder egg. One person said both children and Kinder egg. The difficulty with this is that in articulating the question the interviewer had to adopt a particular pronunciation and it seems likely that a short 'i' sound was adopted rather than the long 'i' of the English comparative adjective kinder. If that is so the question was, despite appearances, a leading one or likely to invite speculation.

The combined effect of the deficiencies is, in my view, to severely diminish, if not destroy, the value of the surveys. The opponents might feel able to draw some limited support from the surveys in terms of public awareness of, particularly, the KINDER SURPRISE egg product. But the applicants too can point with some legitimacy to the fact that a number of interviewees were also aware that KINDER meant children (indeed a few referred to both the trade mark significance and the fact that it was a word meaning children).

Turning to the applicants' evidence, I have not found the dictionary material to be persuasive particularly the foreign language ones intended to demonstrate that kind/kinder are words in other languages meaning child or children. As Ms Edenborough pointed out, dictionaries do

not tell you how familiar the general public are with particular words. That is, a fortiori, the case where a foreign language word is involved. Where 'kinder' appears in an English dictionary (Exhibit DJR3 to Ms Harris' Exhibit BPBH3) it is only as part of an expression (kinder, kirche, küche - children, church, kitchen).

Perhaps the most telling point in support of recognition and understanding of the word KINDER in this country is the fact that it will be familiar to many people through the word Kindergarten. That is a word with which, I would think, most people would be familiar and would have an appreciation of its meaning. The word KINDER is also without question a common word of the German language and one that is likely to be understood by anyone with a smattering of that language. The company name information contained in Ms Harris' evidence and followed up in Mr Moore's evidence also provides some support for the view that the word is used in this country in circumstances where it is intended to carry a reference to children.

I am, however, unable to go as far as Mr Arnold when he suggests that the word has become part of the English language. Foreign words and expression are sometimes so completely absorbed into the language that they will be used rather than an English language paraphrase (eg entrepreneur, élan, déjà vu, al fresco). I do not think an English speaker would normally use the word Kinder in place of children. Nor is there likely to be universal understanding of the word. Nevertheless it is in my view likely to command a reasonable level of recognition in this country.

That is not to say that it is incapable of assuming or acquiring a trade mark character. The way in which the word is used, the goods in relation to which it is used, the context and surrounding circumstances will determine whether it has done so.

I have not felt able to place particular reliance on decisions of overseas Registries in relation to the German word Kinder or its English equivalent appearing in, or as part of, marks. Those decisions are not binding on me and cannot be taken as reliable indicators of public perception of, and reaction to, the word in this country.

As part of their case the applicants have also referred to a number of 'KINDER' marks in use in this country in relation to products for children. Those specifically relied on are KINDERGEN which is used as a food substitute for feeding children with renal failure (Mr Morris' evidence), KINDERVITAL which is a children's dietary supplement (Mr Moore's evidence) and KINDERBOX, a box for storing children's books and nursery furniture (Mr Moore's evidence). The suggestion is that this shows the word KINDER in use in relation to products relating to children; that the opponents have no monopoly on the word; and that these marks have been used without any suggestion of confusion with the opponents' goods.

From the material supplied in support of this it would appear that KINDERGEN is a prescription only product. Mr Morris records that his contact at the suppliers of the product indicated it was not a big seller. No information is given on how long the KINDERVITAL products has been available in the UK or the volumes sold. KINDERBOX is used in a product area some way removed from the opponents' mainstream business. I am not inclined to accept that this evidence tells me anything about the issue of confusion with the opponents' goods. To the extent that it reinforces other parts of the evidence which point to the word

Kinder being used for its descriptive connotations across a broad range of goods and services it is a not altogether surprising state of affairs.